

REMARKS

Claims 2, 3, 6, 7, 9, 11, and 23-34 remain pending and under current examination. By this Amendment, Applicants amend claims 23, 24, 25, 26, 27, and 28. This amendment improves the form of, but does not narrow, the pending claims.

In the Final Office Action¹, the Examiner rejected claims 2, 3, 9, 11, 23, 25-27, 30, and 33 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,185,535 to Hedin et al. ("Hedin"). The Examiner further rejected claims 6 and 7 under 35 U.S.C. § 103(a) as being unpatentable over *Hedin* in view of U.S. Patent No. 6,493,671 to Ladd et al. ("Ladd"). The Examiner further rejected claims 24, 28, 31, and 34 under 35 U.S.C. § 103(a) as being unpatentable over *Hedin* in view of U.S. Patent No. 6,263,313 to Milsted et al. ("Milsted"). The Examiner further rejected claims 29 and 32 under 35 U.S.C. § 103(a) as being unpatentable over *Hedin* in view of U.S. Patent No. 5,999,940 to Ranger ("Ranger").

Applicants respectfully traverse the rejection of claims 2, 3, 9, 11, 23, 25-27, 30, and 33 as allegedly anticipated by *Hedin*.

Independent claim 23, for example, recites a contents selection system comprising, among other things, a server which "selects the second category or third category based upon which category will better narrow the first contents list". *Hedin* fails to teach or suggest at least this element of claim 23.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

The Examiner asserts that the “list of options” disclosed by *Hedin* corresponds to the “contents list” as recited by claim 23. Even assuming this is true, and assuming that the “weather information” or “cities” referred to in *Hedin* correspond to the categories in claim 23, *Hedin* does not disclose choosing between the categories of “weather information” or “cities” in order to narrow the “list of options” presented to the user. In other words, *Hedin* does not choose “cities” as the category to present to the user because this will result in the user having to choose from a shorter list of options. Instead, *Hedin* selects the category of “cities” whenever the weather service is used, as evidenced by the fact that the WML tag for the weather service unconditionally chooses “city” as the “category” (*Hedin* col. 14-15). Therefore, *Hedin* fails to teach at least this element of claim 23.

Because *Hedin* fails to teach at least this element of claim 23, *Hedin* cannot anticipate claim 11 under 35 U.S.C. § 102(e). Accordingly, Applicants respectfully request the Examiner allow claim 23. Although of different scope, amended independent claims 25, 26, and 27 recite features similar to those of claim 23. *Hedin* therefore does not anticipate claims 25, 26, and 27 for at least the reasons discussed above with respect to claim 23.

Claims 2, 3, and 30 depend from claim 23, claim 9 depends from claim 25, and claims 11 and 33 depend from claim 26. Because *Hedin* does not support the rejection of independent claims 23, 25, or 26 under 35 U.S.C. § 102(e), *Hedin* also does not support the rejection of dependent claims 2, 3, 9, 11, 30, and 33 for at least the same reasons set forth above in connection with claim 23. Therefore, Applicants request that

the rejection of claims 2, 3, 9, 11, 30, and 33 under 35 U.S.C. § 102(e) be withdrawn and the claims allowed.

Applicants respectfully traverse the rejection of claims 6, 7, 24, 28, 29, 31, 32, and 34 under 35 U.S.C. § 103(a). Claims 6, 7, 24, 29, and 31 depend from independent claim 23, claim 28 depends from independent claim 27, and claims 32 and 34 depend from independent claim 26. As already discussed, *Hedin* fails to disclose selecting “the second category or third category based upon which category will better narrow the first contents list” as recited by each of the independent claims. The remaining references cited by the Examiner also fail to disclose this element.

Because the cited references fail to teach or suggest each and every claim element recited by claims 6, 7, 24, 28, 29, 31, 32, and 34, no *prima facie* case of obviousness has been established with respect to these claims. Applicants therefore respectfully request the Examiner to withdraw the rejection of the claims under 35 U.S.C. § 103(a).

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 2, 3, 6, 7, 9, 11, and 23-34 in condition for allowance. Applicants submit that the proposed amendments of claims 23, 24, 25, 26, 27, and 28 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, because all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is

respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants respectfully request reconsideration of the application and withdrawal of the rejections. Pending claims 2, 3, 6, 7, 9, 11, and 23-34 are in condition for allowance, and Applicants request a favorable action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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